

**REMARKS**

Claims 1, 3-12, 14-23, and 44-65 are pending in the application. Claims 12, 14-23, and 57-65 stand withdrawn in view of the Restriction Requirement. Favorable reconsideration in light of the remarks which follow is respectfully requested.

**Obviousness Rejection**

Claims 1, 3-11 and 44-56 have been rejected under 35 U.S.C. §103(a) over Jackson et al. (US Patent 2,821,500, hereinafter "Jackson") in view of Puterka et al. (U.S. Patent 6,027,740, hereinafter "Puterka"). Jackson relates to an insecticidal composition containing non-porous, water-insoluble granules, gelatin, and mineral oil. The particle size of the granules range between 3 screen mesh and 100 screen mesh (column 2, lines 25-31 and column 3, lines 35-40 of Jackson). The granules include oyster shell, sand, quartz and granite. Puterka relates to a method for protecting surfaces from arthropod infection. The method includes treating the surface with finely divided calcined kaolins, hydrous kaolins, calcium carbonates and so on (abstract of Puterka). Applicants respectfully request withdrawal of the rejection for at least the following reasons. The cited art does not teach or suggest all the features of the claims.

To reject claims in an application under §103, an examiner must establish a prima facie case of obviousness. A prima facie case of obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the cited art or in the knowledge generally available to one of ordinary skill in the art, to modify or combine cited art teachings. Second, there must be a reasonable expectation of success. Finally, the cited art must teach or suggest all the claim features. See MPEP §706.02(j).

In addition, the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the cited art and not based on

applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As the Examiner concedes, Jackson does not teach or suggest 1) the use of calcined materials in the composition, 2) the use of hydrous kaolin in the composition, 3) the colorants listed in claim 7, 4) the use of modified phthalic glycerol alkyl resins, plant oil based materials with emulsifiers, polymeric terpenes, and nonionic detergents in the composition, 5) the particulate material having a particle size of about 100 microns or less or the narrower limitations of 10 microns or less; 3 microns or less; and 1 micron or less, 6) the composition in the form of a powder, slurry or emulsion, and 7) the composition further comprising plant producing media (pages 5 and 6 of the Final Office Action). In addition, Jackson does not disclose particulate material containing at least one of talc, kaolin, beneficiated kaolin, bentonites, pyrophyllite, feldspar, chalk, limestone, precipitated calcium carbonate, diatomaceous earth, barites, and calcined calcium carbonate, calcined talc, calcined kaolin, baked kaolin, fired kaolin, hydrophobic treated heat treated kaolin, calcined bentonites, calcined clays, calcined pyrophyllite, calcined silica, calcined feldspar, calcined sand, calcined quartz, calcined chalk, calcined limestone, calcined precipitated calcium carbonate, baked calcium carbonate, calcined diatomaceous earth, calcined barytes, calcined aluminum trihydrate, calcined pyrogenic silica, and calcined titanium dioxide, as required in claim 1.

However, the Examiner contends that it would have been obvious to one of ordinary skill in the art to use calcined kaolin or hydrous kaolin of Puterka in the composition of Jackson. Applicants respectfully disagree for at least the following reasons.

One skilled in the art would NOT have replaced the granules of particle size from 3-100 screen mesh of Jackson with the finely divided powder of Puterka because this replacement would FRUSTRATE the purpose and teachings of Jackson. The purpose

of Jackson is to provide granular insecticide composition that is "easily applied by hand" by employing the granular of relatively large particle size (column 1, lines 58-72 of Jackson). Jackson expressly states that the granular insecticide of Jackson is distinct from a powder composition such as the finely divided calcined materials and hydrous kaolin of Puterka as follows:

**The granular insecticide of the present invention is not to be confused with a dry pulverulent powder** which is the type of pest control composition which is conventionally applied as a dust or spray. In contrast, **our granular insecticide is relatively free of unattached pulverulent particles. The physical nature of the product of the present invention permits it to be easily applied by hand and the particles composing it are much easier to direct to the focal area, even though there are air currents, than a powdered product would be under the same atmospheric conditions;** then too, more of the product of the present invention comes to rest upon the selected focal area and not upon other surfaces where an application of the insecticide is undesired, since it is not carried away by the wind. (column 1, lines 58-72 of Jackson, emphasis added).

To distinguish the granular from the dry pulverulent power, Jackson requires granular substrates of particle size from 3-100 screen mesh as follows:

The granular insecticide of the present invention is characterized by inorganic, water-insoluble, non-porous granules, preferably oyster shell or other calcareous shell of **particle size range from 3 to 100 screen mesh**, inclusive, coated with an oil and an oil-dispersible, organic toxicant for the insect and an organic attractant for the insect. (column 2, lines 25-31 of Jackson, emphasis added)

...

In the present invention, **the term "granular" is understood to mean the carrier material of particle sizes which will pass through screens ranging from one-fourth inch, i. e., substantially mesh size 3 as the largest size, to 100 screen mesh as the smallest size,** inclusive (Tyler Standard Screen Scale Series of the W. S. Tyler Company). (column 3, lines 45-49 of Jackson, emphasis added)

...

The **disadvantage of particles finer than 100 screen mesh** and even particles smaller than 40 mesh is that the product made therefrom is likely to be dusty, and dustiness is not desirable. There usually is a very minor, incidental amount of powder in the granular, inorganic solid material of size range one-quarter inch-100 screen, mesh. (column 4, lines 5-8 of Jackson, emphasis added).

The granules of Jackson have a particle size of 150  $\mu$ m to 6.73 mm since a 100 mesh screen has openings of 150  $\mu$ m and a 3 mesh screen has openings of 6.73 mm.

It would NOT have been obvious to one of ordinary skill to replace calcined kaolin or hydrous kaolin of Puterka with the granules of Jackson since Puterka's finely divided powder has a particle size under 150  $\mu$ m. Puterka's finely divided powder has a median particle size below about 10  $\mu$ m (column 4, lines 23-27 of Puterka). Puterka's powder is one that Jackson expressly states not to confuse with the granules (column 1, lines 58-61 of Jackson). Puterka's powder has an "disadvantage" to Jackson's granular composition because the powder has a particle size of under 150  $\mu$ m (column 4, lines 5-8 of Jackson). One skilled in the art would not confuse these objectives and results. Consequently, one skilled in the art would NOT have been motivated to use the powders of Puterka in the granular composition of Jackson.

The Examiner contends that "[o]ne of ordinary skill in the art seeking to improve the safety of using the composition of Jackson et al. would have sought alternative means of application, such as spraying, and used a smaller particle size, as suggested by Puterka et al., in the spraying formulation" (page 7 of the Final Office Action). Applicants respectfully disagree.

The Examiner's contention is based only on impermissible hindsight, made with the guidance of the instant specification. Jackson teaches that sprays are "disadvantageous" because the application of spays is laborious and requires mechanical sprayer equipment (column 1, lines 44-49 of Jackson). Jackson further

teaches that due to the granules, an advantage of Jackson's composition is "free from dust formation" when applying of the granules as follows:

This invention relates to an insecticidal composition in a **free-flowing, granular form**, which composition is particularly effective against flies . . . . Another advantage is that it can be readily applied by hand or mechanically. Nevertheless, it exhibits relative **freedom from dust formation** either in pouring or shaking it from containers or on scattering it by hand upon surfaces. It is both relatively **free of loose, unattached pulverulent particles** and substantially free from clumping. (column 1, lines 15-31 of Jackson, emphasis added).

One skilled in the art seeking to improve the safety of using Jackson's granules would NOT have reasonably inferred from the teachings of Jackson that the granules are replaced with finely divided powders of Puterka and then applied by sprays. Jackson teaches the opposite. Specifically, Jackson teaches that an application of sprays of finely divided powders is disadvantageous due to laboriousness, necessity of spray equipment, and dust formation. The dust formation associated with using an insecticidal composition of Puterka's small particle size would in fact increase safety risk.

Since Jackson's composition contains "toxicant chemicals," Jackson prohibits the use of finely divided powders so as to avoid dangerous dust formation. While Puterka teaches finely divided powders, the finely divided particles are one that Jackson claims not to be confused with Jackson's granules. The cited art does not only fail to teach or suggest replacement of Jackson's granules with Puterka's finely divided particles, but the cited art in fact teaches away from the claims. From the teachings of the cited art, one skilled in the art would NOT have been motivated to use Puterka's finely divided powders in applying Jackson's granular insecticidal composition.

Accordingly, withdrawal of this rejection is respectfully requested.

Rejoinder

During prosecution, the claims were subjected to the following restriction requirement, in part:

Group I (claims 1, 3-11, and 44-56), drawn to a composition containing a particulate material; organic non-vegetable non-fuel high boiling oil; and at least one additive selected from the group consisting of ionic salt, colored particle, or surfactant; and

Group II (claims 12, 14-23, and 57-65), drawn to a method of controlling pests including applying the composition of claim 1.

MPEP 821.04 specifies that, where product and process claims are presented in the same application, and if product claims are elected in a Restriction Requirement, after a product claim is found allowable, withdrawn process claims which depend from or include all the limitations of the allowable product claim will be rejoined.

Independent method claim 12 was amended to include all of the features of claim 1. Thus, in the event that claim 1 is deemed allowable, per MPEP 821.04, rejoinder of the method claims 12, 14-23, and 57-65 is respectfully requested.

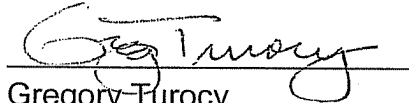
Should the Examiner believe that a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

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In the event any fees are due in connection with the filing of this document, the Commissioner is authorized to charge those fees to our Deposit Account No. 50-1063.

Respectfully submitted,  
AMIN, TUROCY & CALVIN, LLP

A handwritten signature in dark ink, appearing to read "Greg Turocy", is written over a horizontal line.

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